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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Appln. of: Philip T. Kortum

Appln. No.: 09/847,045

Filed: May 1, 2001

For: Unified Digital Subscriber Line Self-  
Installation Process and Kit

Attorney Docket No: 8285/431

Examiner: Igor N. Borissov

Art Unit: 3629

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL**

Sir:

**Attached is/are:**

- Check for \$500 to cover Appeal Brief; Transmittal Cover Letter (1p. Filed in Dup.); Appeal Brief (13pp.)
- Return Receipt Postcard.

**Fee calculation:**

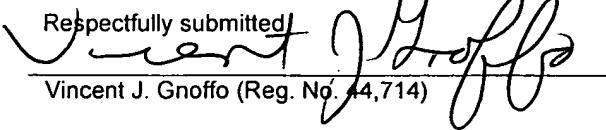
- No additional fee is required.
- Small Entity.
- An extension fee in an amount of \$\_\_\_\_ for a \_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).
- A petition or processing fee in an amount of \$\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_).
- An additional filing fee has been calculated as shown below:

|   | Claims Remaining<br>After Amendment |       | Highest No.<br>Previously Paid For | Present<br>Extra | Small Entity |           | Not a Small Entity |          |
|---|-------------------------------------|-------|------------------------------------|------------------|--------------|-----------|--------------------|----------|
|   |                                     |       |                                    |                  | Rate         | Add'l Fee | or                 | Rate     |
| Total                                     | 20                                  | Minus | 20                                 | 0                | x \$25=      |           |                    | x \$50=  |
| Indep.                                    | 3                                   | Minus | 3                                  | 0                | X100=        |           |                    | x \$200= |
| First Presentation of Multiple Dep. Claim |                                     |       |                                    |                  | +\$180=      |           |                    | +\$360=  |
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- Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.
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- The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Feb. 15, 2007  
Date

Respectfully submitted  
  
Vincent J. Gnoffo (Reg. No. 44,714)

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PATENT  
CASE NO. 8285/431

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Philip T. Kortum )  
Serial No. 09/847,045 ) Examiner: Igor N. Borissov  
Filing Date: May 1, 2001 ) Group Art Unit No. 3629  
For Unified Digital Subscriber Line Self- )  
Installation Process and Kit )

**APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

This Appeal Brief is filed based on the final rejection of all pending claims mailed on October 5, 2006, and further to the Notice of Panel Decision from Pre-Appeal Brief Review mailed January 25, 2007.

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**I. Real Party in Interest**

The real party in interest for the above-referenced application is SBC Technology Resources, Inc., whose address is 9505 Arboretum Boulevard, Austin, Texas 78759. See Reel/Frame 012095/0875.

**II. Related Appeals and Interferences**

The undersigned is unaware of any other appeals or interferences that will directly affect, be directly affected by or have any bearing on the Board's decision in the pending appeal.

**III. Status of Claims**

Claims 2, 9, 17 and 21 are canceled.

Claims 1, 3-8, 10-16 and 18-20 are pending and stand finally rejected.

All of finally rejected claims 1, 3-8, 10-16 and 18-20 are appealed.

**IV. Status of Amendments**

No amendments are pending.

**V. Summary of Claimed Subject Matter**

In the claimed embodiments, a digital subscriber line (DSL) self installation kit includes at most one instruction manual which describes a unified installation process with instructions to install all of a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable connection software code. (*E.g.*, p. 1, lines 17-18). The system disclosed can help address the shortcomings of prior systems, such as systems that included a separate instruction manual for each unit in the kit, which led to an undesirably high rate of failures and frustration for customers who attempted to self-install DSL. These failures lead to help desk calls and, in certain cases, the dispatch of technicians to the customer's premises.

Independent claim 1 recites a digital subscriber line self installation kit. (*See e.g.*, Fig. 4 and p. 4, lines 15-21). The kit includes a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable medium whose contents

comprise computer readable connection software code. (See e.g., Figs. 1 and 3 and p. 2, lines 4-9 and p. 4, lines 22-31). The kit also includes at most one instruction manual which describes a unified installation process. The unified installation process provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code. (See e.g., page 5, lines 5-22). The at most one instruction manual requires no operating system selection by a user and corresponds to an operating system of the user. (p.5, lines 23-31)

Independent claim 8 recites a digital subscriber line self installation kit. (See e.g., Fig. 4 and p. 4, lines 15-21). The kit includes a network card, a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable medium whose contents comprise computer readable connection software code. (See e.g., Figs. 1 and 3 and p. 2, lines 4-9 and p. 4, lines 22-31). The kit also includes at most one instruction manual which describes a unified installation process. The unified installation process provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code. (See e.g., page 5, lines 5-22). The at most one instruction manual requires no operating system selection by a user and corresponds to an operating system of the user. (p.5, lines 23-31)

Independent claim 16 recites a digital subscriber line self installation kit. (See e.g., Fig. 4 and p. 4, lines 15-21). The kit includes a network card, a digital subscriber line modem, at least one digital subscriber line filter, and a computer readable medium whose contents comprise computer readable connection software code. (See e.g., Figs. 1 and 3 and p. 2, lines 4-9 and p. 4, lines 22-31). The kit also includes at most one instruction manual which describes a unified installation process. The unified installation process provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code. (See e.g., page 5, lines 5-22). The at most one instruction manual requires no operating system selection by a user and corresponds to an operating system of the user. (p.5, lines 23-31)

## **VI. Grounds of Rejection to be Reviewed on Appeal**

1. Whether claims 1, 5-7, 8, 12-15, 16 and 20 are unpatentable under 35 U.S.C. 103(a) in view of the combination of "SBC global network DSL: Customer Self Install" (SBC Document) and Klees (U.S. 5,283,661).
2. Whether claims 3-4, 10-11 and 18-19 are unpatentable under 35 U.S.C. 103(a) in view of the combination of the SBC Document, Klees and Official Notice.

## **VII. Argument**

Appellant submits that the pending rejections fail 1) to cite references teaching or suggesting all of the claimed features; or 2) to meet the requirement of adequately showing a teaching or suggestion to combine the cited references.

### **A. Ground 1**

Appellant submits that the rejection of claims 1, 5-7, 8, 12-15, 16 and 20 under 35 U.S.C. 103(a) in view of the combination of "SBC global network DSL: Customer Self Install" (SBC Document) and Klees (U.S. 5,283,661) should be withdrawn.

#### **Claim 1**

Pending independent claim 1 recites a digital subscriber line self-installation kit with "at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code".

Klees describes a method and apparatus for detecting that a facsimile machine is being installed, and the Klees system has nothing to do with digital subscriber lines. The system of Klees uses information stored within the facsimile machine to aid the installer during installation and/or operation of the facsimile machine. The system uses either image and text information or verbal information stored in the memory of the facsimile machine. The system was put in place because purchasers of facsimile machines often found the instruction manuals difficult to read and only used them as a last resort. See Klees Background. The Office Action points to the Background of Klees for the proposition that it would have been obvious to include an instruction manual in the system of the SBC Document to simplify the installation process by providing an instruction manual to install all elements of the kit. This is a stretch of

logic, however, since Klees does not disclose that at most one instruction module would be used. Moreover, Klees is interested in removing the need for an instruction manual altogether. Klees discloses storing instructions into a read only memory (ROM) of the machine and automating the installation process to assist the user so that they do not have to rely on the manual. In addition, the facsimile system of Klees does not disclose or suggest the at most one instruction manual for providing instructions to install all of a digital subscriber line modem, digital subscriber line filter, and computer readable connection software code, as in claim 1. The facsimile machine of Klees has nothing to do with such components, and indeed, is the facsimile machine is the only component to be set up. Unlike the claimed embodiments, there are no multiple components in Klees to set up.

The SBC Document fails to fill the gaps of Klees. While the SBC Document related to installing digital subscriber lines, the Office Action correctly points out that the SBC Document does not describe at most one instruction manual for the installation process of the digital subscriber line. The SBC Document also does not disclose or suggest that the at most one instruction manual provides instructions to install all of the digital subscriber line modem, the at least one digital line filter, and the computer readable connection software. As described in the Background section of the application as filed, multiple instructions manuals, one for each different part of the system, were provided.

Therefore, for at least these reasons, Appellant respectfully requests that the rejections to the claims be withdrawn and the claims be considered allowable.

Moreover, Appellant submits that it would not have been obvious to incorporate the features of the SBC Document with the Klees. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01.

There is no motivation to combine the facsimile machine installation system of Klees with the digital subscriber line customer self-install program of the SBC Document. The system of Klees describes a method and apparatus for storing

information within a facsimile machine and automating the installation process to aid the installation of a single machine, i.e., the facsimile machine. The SBC Document relates to the installation of various, disparate components together to enable a digital subscriber line system, such as for use with the Internet. The patent application as filed noted that a problem to be addressed by the claimed invention was that known self-installation kits included various disparate components, each with their own manual. There was a problem with self-installation kits in that a user may have been uncertain as to which manual, of the multiple manuals, to read first. User testing showed that critical installation steps were often missed with such self-installation kits having multiple manuals. Further, conflicting information may have been present in different manuals since vendors typically constructed their manuals in isolation from each other. See Background. On the contrary, Klees describes the installation of a single component, a facsimile machine. There is no explicit or implicit teaching in either reference to combine the disclosed systems, such as to address these stated problems. Indeed, the system of Klees attempts to remove installation manuals from the system since such manuals are considered "difficult and unwieldly". Col. 1, ll. 14-16 of Klees. While both systems may generally relate to installations, the specific disclosed systems and installation processes described are very different from each other, and therefore it is inappropriate to combine the references. For at least this additional reason, Appellant submits that the rejection should be withdrawn.

Claims 5-7 depend from claim 1, and are submitted to be allowable for at least the same reasons as provided for claim 1.

### **Claim 8**

Pending independent claim 8 recites a digital subscriber line self-installation kit with "at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code". For at least the reasons discussed above with regard to claim 1, Appellant respectfully requests that this rejection also be withdrawn. Claims 12-15 depend from claim 8, and are submitted to be allowable for these same reasons.

### **Claim 16**

Pending independent claim 16 recites a digital subscriber line self-installation kit with “at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, the computer readable connection software code and the computer readable internet service provider specific software code”. For at least the reasons discussed above with regard to claim 1, Appellant respectfully requests that this rejection also be withdrawn. Claim 20 depends from claim 16, and is submitted to be allowable for at least these same reasons.

### **B. Ground 2**

With regard to claims 3-4, 10-11 and 18-19, Official Notice was taken by the Office Action that it is well known to provide goods ordered by customers in shipping containers. Appellant contends that the Official Notice was taken for the recited element, outside the context of the claims. Appellant requests that, if the rejection is maintained, a reference be provided in place of the Official Notice regarding the features as claimed, e.g., the container that contains the unified instruction manual, the digital subscriber line modem, the at least one digital subscriber line filter and the computer readable medium. See MPEP 2144.03 (C).

Moreover, claims 3-4 depend from claim 1, claims 10-11 depend from claim 8, and claims 18-19 depend from claim 16, and therefore should be allowable for at least the same reasons as provided by claims 1, 8 and 16, respectfully.

## **CONCLUSION**

For the reasons provided above, Appellant submits that claims 1, 3-8, 10-16 and 18-20 are allowable over the cited art. Appellant respectfully submits that the outstanding rejections of the claims as unpatentable is in error and should be reversed.

Respectfully submitted,



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## **VIII. Claims Appendix**

1. A digital subscriber line self installation kit comprising:

- a digital subscriber line modem;
- at least one digital subscriber line filter;

a computer readable medium whose contents comprise computer readable connection software code; and

at most one instruction manual which describes a unified installation process which provides instructions to install all of the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code, wherein the instruction manual requires no operating system selection by a user and wherein the at most one instruction manual corresponds to an operating system of the user.

3. The kit of claim 1 further comprising a container which contains the digital subscriber line modem, the at least one digital subscriber line filter and the computer readable medium.

4. The kit of claim 3 wherein the container contains the instruction manual.

5. The kit of claim 1 wherein the instruction manual provides a point of contact telephone number associated with the digital subscriber line modem.

6. The kit of claim 1 wherein the instruction manual provides a point of contact telephone number associated with the at least one digital subscriber line filter.

7. The kit of claim 1 wherein the instruction manual provides a point of contact telephone number associated with the computer readable connection software code.

8. A digital subscriber line self installation kit comprising:

- a network card;
- a digital subscriber line modem;
- at least one digital subscriber line filter;

a computer readable medium whose contents comprise computer readable connection software code; and

at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer readable connection software code, wherein the instructions manual requires at most one operating system selection by a user, wherein the operating system selection step comprises selecting the at most one instruction manual.

10. The kit of claim 8 further comprising a container which contains the network card, the digital subscriber line modem, the at least one digital subscriber line filter and the computer readable medium.

11. The kit of claim 10 wherein the container contains the instruction manual.

12. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the network card.

13. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the digital subscriber line modem.

14. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the at least one digital subscriber line filter.

15. The kit of claim 8 wherein the instruction manual provides a point of contact telephone number associated with the computer readable connection software code.

16. A digital subscriber line self installation kit comprising:

- a network card;
- a digital subscriber line modem;
- at least one digital subscriber line filter;
- at least one computer readable medium whose contents comprise computer readable connection software code and computer readable internet service provider specific software code; and

at most one instruction manual which describes a unified installation process which provides instructions to install all of the network card, the digital subscriber line modem, the at least one digital subscriber line filter, the computer readable connection software code and the computer readable internet service provider specific software code, wherein the instruction manual requires at most one operating system selection step by a user, wherein the operating system selection step comprises selecting, from the at most one instruction manual, a section of the instruction manual corresponding to an operating system of the user.

18. The kit of claim 17 further comprising a container which contains the network card, the digital subscriber line modem, the at least one digital subscriber line filter and the at least one computer readable medium.
19. The kit of claim 18 wherein the container contains the instruction manual.
20. The kit of claim 16 wherein the instruction manual provides a point of contact telephone number provider specific software code.

## **IX. Evidence Appendix**

None

**X. Related Proceedings Appendix**

None